



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,876	08/18/2006	Jordi Tormo i Blasco	5000-0192PUS1	2828
2292 7590 06/22/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MURRAY, JEFFREY H				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
06/22/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/589,876

Applicant(s)

BLASCO ET AL.

Examiner

JEFFREY H. MURRAY

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 4, 8, 10 and 14-17 are pending in this application. Claims 2, 3, 5-7, 9, 11-13 and 18 have been cancelled. This action is in response to the applicants' amendment after a non-final and reply filed on June 6, 2008. It is noted that a typographical error occurred in the prior action with regards to claim 5. In addition to being objected, claim 5 should have also been rejected under 103(a) for the same reasons as was stated in the prior action using the same Eicken '303 document. Examiner will apply the declaration and the arguments of the current response to claim 5 as well as claims 1-4 and 8.

Withdrawn Rejections/Objections

2. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

Claim Rejections - 35 USC § 103

3. Claims 1-5 and 8 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken, et. al. U.S. Patent No. 4,617,303, in view of *In re Hass et al.* (CCPA 1944) 141 F2d 122 and 127, 60 USPQ 544 and 548; and *In re Henze* (CCPA 1950) 181 F2d 198, 85 USPQ 261.

Applicants argued that an affidavit provided, herein known as the "Haden declaration" compares the closest disclosed examples of the prior art cited, herein

known as Eicken '303, against compounds examples falling within the scope of the present claims.

Applicants have chosen compounds from the Eicken '303 document which were previously cited as 103(a) compounds for being homologs of the present application's compounds. '303 does not contain just one, but six different compounds which would be considered 103(a) obvious type variations of the current application. Applicants presented a declaration stating that it would not have been obvious to attempt to make the homolog variants of these compounds and show evidence of stated unexpected results to support their position. In the declaration, applicants show six different compounds present in the prior art and test them side-by-side with six compounds of the present application which are homologs of the prior art compounds. The testing results are not found convincing for two reasons.

First, not one of the compounds used in applicant's declaration correspond to the species compound, 6-octyl-5-propyl[1,2,4]triazole[1,5-a]pyrimidin-7-ylamine, which was elected under the species requirement in the action dated December 21, 2007. Therefore these arguments and declaration do not overcome a rejection against the elected species. Claims 1-5 and 8 remain rejected as the genus claim of the prior art continues to read on them.

Second, while it is true that for one specific test, against one specific compound, the current application homolog compound appears to have better results, one must look at the genus as a whole, not a specific single species. In column 12 of the '303 patent, under Example 1, which tests action on *Plasmopara viticola* states, "The results

of the experiment show that for instance compounds nos....16,...21,...25...had a better fungicidal action (ex. 97%)..." Again we see in column 12 and 13 of the '303 patent, under Example 2, which tests action on *Phytophthora infestans* states, "The results of the experiment show that for instance compounds nos....16,...21,...25, 48...had a better fungicidal action (ex. 90%)..." These results show that the compounds are potent antifungal agents. Applicants state that when tested on *Phytophthora infestans*

While the applicants may find that one or two of the prior art species compounds are not as active as antifungal agents in comparison to the current applicant's compounds, this presumption cannot be spread across the entire genus. In particular when the prior art openly states that compounds #16, 21 and 25 are 97% effective when tested against *Plasmopara viticola* and that compounds #16, 21, 25 and 48 are 90% effective when tested against *Phytophthora infestans*.

One having ordinary skill in the art would have been motivated to prepare the species compound as it falls under the genus of the prior art claims and is useful for the same purpose, that of a fungicidal agent. The results shown by the applicants do not show unexpectedness across the entire scope of the genus. It has been held that compounds that are structurally homologous to prior art compounds are *prima facie* obvious, absent a showing of unexpected results. *In re Hass*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950).

Conclusion

4. Claims 1-5 and 8 are rejected.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/
Patent Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624